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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Robert D'Amato

Confirmation No.: 3798

Application No.: 09/704,054

Group Art Unit: 1614

Filed: November 1, 2000

Examiner: Rebecca Cook

For: METHODS FOR INHIBITION OF
ANGIOGENESIS

Attorney Docket No.: 9516-039-999

For fee only

RESPONSE UNDER 37 C.F.R. § 1.111

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed July 27, 2004, please enter and consider the amendment and remarks below. A petition for extension of time is submitted with authorization to charge any required fee.

The Commissioner is hereby authorized to charge any required fee(s) to Jones Day Deposit Account No. 50-3013. A copy of this sheet is enclosed for such purpose.

Amendments to the claims are reflected in the listing of the claims that begins on page 2 of this paper.

Remarks begin on page 7 of this response.

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The Rejection Under Obviousness-Type Double Patenting Should Be Withdrawn

On pages 3-4 of the Office Action, the pending claims are rejected under the judicially created obviousness-type double patenting over claim 1 of U.S. Patent No. 5,629,327 ("the '327 patent"). Applicant respectfully traverses this rejection.


The Examiner alleges that the conflicting claims are not patentably distinct from each other, because the '327 patent discloses a method of using thalidomide to treat undesired angiogenesis and thalidomide inhibits cancer by preventing said undesired angiogenesis. Claim 1 of the '327 patent is directed to a method of treating undesired angiogenesis in a human or animal comprising administering to the human or animal with the undesired angiogenesis a composition comprising an angiogenesis-inhibiting amount of thalidomide. The Examiner has not demonstrated that claim 1 of the '327 patent teaches or suggests the methods of inhibiting tumor formation and tumor metastasis in humans using thalidomide as recited by the pending claims. Applicant asserts that the pending claims of the invention are different and patentably distinct from claim 1 of the '327 patent. No *prima facie* case of obviousness has been established by claim 1 of the '327 patent. Applicant respectfully requests that the rejection of the pending claims under judicially created obviousness-type double patenting be withdrawn. Applicant further submits that no terminal disclaimer over the cited patent is necessary.

Conclusion

Applicant respectfully requests that the above amendment and remarks be entered in the file of this application. Should the Examiner not agree that all claims are allowable, then a further personal or telephonic interview is respectfully requested to discuss any remaining issues and to accelerate the allowance of the above-identified application. No fee is believed due. However, please charge any required fees to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date January 27, 2005


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